

contrary to the contentions of the Examiner would not cover products other than food products. Furthermore, it is the undersigned's understanding that corn syrup utilized in prior methods as disclosed at least at page 2, line 15 and following of the present application was applied as a drop and was not sprayed. It is then respectfully submitted that the Examiner submit evidence that the apparatus of claim 11 can be used to apply corn syrup if the Examiner contend that restriction can be supported on that basis. Further, in order to do a complete and thorough job in the examination of Group I, it will be necessary to search the prior art of Group II. It is then respectfully submitted that for Patent Office economies and efficiencies, the restriction requirement should be removed. Therefore, it is respectfully submitted that the restriction requirement has been overcome for these separate and independent reasons. Favorable reconsideration is respectfully requested.

Zoss is commonly assigned as the present application and was cited at least at page 2, line 11 and following of the present application. As indicated, prevention of unrolling during fabrication was a well known problem to the assignee who has been extensively commercializing the rolled food item of the type of the present invention for a number of years and recognized the need for a solution. Labels are one solution to this problem, but labels resulted in other problems. Zoss is a solution to the problems created by labels. The present invention presents a solution to the unrolling problem by removing the need for labels and thus also eliminates the problems solved by Zoss, and specifically the need is removed for the labels per se either of the type of Zoss or of prior types.

The disclosure of Zoss at least at column 1, lines 31-38 and of page 2, lines 1-21 of the present application was based upon inspection of product on the market manufactured by Farley Candy Company. International Publication No. WO97/33822 is assumed to disclose the manner

of manufacture of that product. Attention is directed to the disclosure thereof wherein it discloses "a system for applying a drop of corn syrup" (page 16, lines 14 and 15, emphasis added); "when triggered, they [nozzles 110] each dispense one drop of corn syrup" (page 16, lines 31 and 32, material in brackets and emphasis added); "the drop of corn syrup is placed in the correct spot" (page 16, line 37-page 17, line 1, emphasis added); "deposit the drop" (page 17, line 2, emphasis added); "the ball valve allows a drop of corn syrup to pass out of the nozzle 110" (page 17, lines 13-14, emphasis added), and the like. It should then be appreciated that the use of corn syrup does not act as a source of moisture increasing the tackiness of the food itself in a manner as the present invention. Additionally, there is no disclosure that the corn syrup or other "edible adhesive" is sprayed or has the ability to be sprayed or that the tackiness of the food could be increased to hold a roll in position during packaging or that water could be utilized for holding a roll in position during packaging.

It should be noted that in the most preferred form, food 14 is a sweetened dehydrated fruit-based material (claims 9 and 18). In particular, food 14 has a moisture content which enhances its shelf life and particularly does not result in undesirably degrading during normal storage times before consumption (page 8, line 19 and following of the present application). In particular, if the moisture content was too high, food 14 may degrade such as by molding (page 11, lines 27-35 of the present application). It is believed that this is one of the reasons that corn syrup or similar adhesive was previously utilized, as the adhesion was based upon the qualities of the corn syrup and not the food itself and the moisture content of the food was not significantly increased.

Shapiro teaches adherence of sheets and/or strips of dough together. It should then be appreciated that the express teachings of Shapiro are limited to doughs which require further

cooking either by the manufacturer or the consumer. Furthermore, the use of water is taught since the doughs "include a grain flour already" (column 6, line 2 of Shapiro). It is then respectfully submitted that Shapiro does not face or solve the problems presented in the field of the present invention.

In particular, Although Shapiro discloses the use of a binding agent such as paste or water between sheets of dough, Shapiro does not suggest that water can be utilized to increase adherence of a food which does not include a grain flour or to increase adherence of a food (whether it includes grain flour or not) to a strip of support material or that water can be utilized to prevent unintentional unrolling of a roll (whether formed of food or formed of food and a strip of support material as in the present invention). It is respectfully requested that the Examiner identify why a person skilled in the art would consider Shapiro absent the hindsight teachings of the present invention. In particular, since Shapiro does not provide any teachings relating to adhering food to a support material or to the creation of a rolled food item, why would a person skilled in the art even consider Shapiro to be relevant to problems in the field of the present invention absent the hindsight knowledge of the present invention. As stated by the CCPA in *In re Van Wanderham, Worthley, and Comolli*, 154 USPQ 20, 24, 25 (1967):

Closely related to the doctrine of nonanalogous art is the doctrine forbidding hindsight reconstruction, also discussed in Potts, supra. In applying section 103, the Supreme Court recently cautioned against "slipping into hindsight." (case citations)

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The opinion in *Sporck* further provides, 49 CCPA at 1043, 44, 45; 133 USPQ at 363, 364:

Once appellant's solution to the problem of making a tapered wall frusto-cone is disclosed, it is easy to see how the prior references can be modified and manipulated to produce this type of cone. The change admittedly is simple and by hindsight seems obvious. However, the simplicity of new inventions

is oftentimes the very thing that is not obvious before they are made.

* * *

It is of course true that the examiner was able to locate the Sato article. However, it appears that this was done through reading into the art the teachings of appellants' invention. In *re* Murray. We think the Patent Office's conclusion of obviousness is based on an impermissible hindsight reconstruction of the art. In *re* Sprock.

Our determination here is not without difficulty. However, we think the difficulty arises from not considering the subject matter as a whole and instead of focusing on the scientific principle involved . . .

Likewise, the CCPA stated in *In re Shapleigh*, 115 USPQ 129, 133 (1957):

The test as to whether two references are from non-analogous arts is whether one seeking to solve a problem with respect to the embodiment of a reference in one art would be apt to seek the solution to said problem in the other art. (case citation)

Similarly, the CCPA in *In re Antle*, 170 USPA 285, 287-288 (1971) stated:

In *Winslow* we said that the principal secondary reference was "in the very same art" as appellant's invention and characterized all the references as "very pertinent art." The language relied on by the solicitor, quoted above, therefore, does not apply in cases where the very point in issue is whether one of ordinary skill in the art would have *selected*, without the advantage of hindsight and knowledge of the applicant's disclosure, the particular references which the examiner applied. As we also said in *Winslow*, "Section 103 requires us to presume full knowledge by the inventor of the *prior art in the field of his endeavor*" . . . but it does not require us to presume full knowledge by the inventor of prior art *outside* the field of his endeavor, i.e., of "non-analogous" art. In that respect, it only requires us to presume that the inventor would have that ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains. (emphasis theirs)

In determining what is analogous art, the Court of Appeals for the Federal Circuit stated in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 USPQ 584 (1984):

In resolving the question of obviousness under 35 U.S.C., § 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combination of teachings from references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

Furthermore, even if the references relied upon by the Examiner were known for some reason, it should be appreciated that the reasons provided by the Examiner to show that the alleged modifications to Zoss are based upon the hindsight knowledge of the present invention for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd., v. Union Oil Co. of Cal.*, 218 USPQ 865, 870 (1983) stated:

All the pieces of the present invention were known in the art, . . . That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. (Case citations.)

Further, the CAFC in *In re Gordon*, 221 USPQ 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Similarly, the Court of Appeals for the Federal Circuit in *In re Sernaker*, 702 F.2d 989, 217 USPQ 1, 5 (1983) stated:

We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art, that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

Likewise, as stated by the CCPA in *In re Kamm and Young*, 172 USPQ 298 at 301 and 302:

The rejection here runs afoul of a basis mandate inherent in Section 103--that "a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure" shall not be the basis for a holding of obviousness. In *re Rothermel*, 47 CCPA 866, 870, 26 F.2d 393, 396, 125 USPQ 328, 331 (1960). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In *re Wesslau*, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965). We think this has been done here.

We appreciate the relative ease with which one can slip into such an error, especially where, as here, the primary reference addresses the same problem as appellants and solves it using merely a different chemical agent. However, we are satisfied that when the secondary references are viewed in their entirety, with due consideration given to what they fail to disclose and what they disclose as undesirable, it is evident that the proposed modification of the primary reference would not have been obvious to one of ordinary skill in the art at the time the invention was made.

Turning to the present application, Zoss discloses the use of a label and the use of edible adhesive such as corn syrup disclosed in the Farley publication. There is no disclosure of any suggestions of any other modifications or the desirability of such modifications in Zoss. Additionally, food 14 of Zoss is disclosed as being a sweetened dehydrated fruit-based material. As there is no disclosure that the food of Zoss includes a grain flour, a person skilled in the art

considering Shapiro would not be suggested to utilize water but would be taught to use an "édible paste" which would be consistent with the teachings of Zoss and Farley. There is no disclosure of utilizing water for non-grain flour based material in Shapiro, Zoss, or Farley. Only the present invention provides the hindsight teachings necessary to select just the right elements and combine them in just the right way to arrive at the recitations of the claims. It is then respectfully submitted that the rejection of claims 1 and 14 and the claims which depend therefrom has been overcome. Favorable reconsideration is respectfully requested.

Assuming that a person skilled in the art considered Shapiro as being pertinent to the problem faced by the food item of Zoss, Shapiro would teach spraying the entire length as there is no teaching in Shapiro that water (or edible paste) would be sprayed on less than the entire length and area at least because Shapiro would be inoperative if water was not sprayed on the entire length. Thus, it is respectfully submitted that the rejection of claims 2, 3, 14, and 15 and the claims which depend therefrom has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

Similarly, claims 6 and 16 further recite that the deposit is spaced inwardly from the side edges of the food. Clearly, a person skilled in the art would not be suggested by Zoss and/or Shapiro to arrive at the recitations of claims 6 and 16. Thus, it is respectfully submitted that the rejection of claims 6 and 16 and the claims which depend therefrom has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

As Shapiro discloses the use of water for "grain flour" doughs, it is respectfully submitted that Shapiro provides no suggestion as to the use of water for sweetened dehydrated fruit-based material as recited in claims 9 and 18. It is then respectfully submitted that the rejection of

claims 9 and 18 has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

Similarly, as Shapiro discloses the use of water for adhering two sheets of dough together, it is respectfully submitted that Shapiro provides no suggestion as to the use of water to adhere food to silicon parchment paper as recited in claims 10 and 19. It is then respectfully submitted that the rejection of claims 10 and 19 has been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

The Examiner has cited the United States Patents listed in NOTICE OF REFERENCES CITED as A and B. By the lack of application of references like them within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicants' labelless, rolled food item and its fabrication which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 1-20, as amended, of the present application and to pass this application to issue.

Respectfully submitted,

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Dated: February 25, 2000

